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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,113	02/02/2004	Sanjay Kalra	1014-070US01/JNP-0316	9356
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SHUMAKER & SIEFFERT, P.A 1625 RADIO DRIVE, SUITE 300 WOODBURY, MN 55125			EXAMINER MAUNG, ZARNI	
			ART UNIT 2151	PAPER NUMBER
			NOTIFICATION DATE 11/21/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@ssiplaw.com

Office Action Summary

Application No.

10/770,113

Applicant(s)

KALRA, SANJAY

Examiner

Zarni Maung

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

This action is responsive to the application filed on February 2, 2004. Claims 1-43 are presented for examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and use the invention, i.e., failing to provide an enabling disclosure.

The applicant has failed to disclose any software or hardware components necessary in the system with any meaningful degree of specificity to perform all the tasks in the communication system.

The applicant has failed to provide an enabling disclosure in the detailed description of the embodiment. On page 4, the applicant states

"[0020] FIG. 1 is a block diagram illustrating an exemplary system 10 in which customer premise devices (CPDs) 12A-12C ("12") automatically communicate service related characteristics and discover information associated with other network devices sharing the same service related characteristics. In addition, CPDs 12 may automatically configure one or more services in accordance with the shared service related characteristics."

On page 8, the applicant explains the most important aspect of the invention

"[0053] Remote client 90 may provide service related characteristics 75 to router 100. Routing engine 72 stores the specified service related characteristics 75. Routing engine 72 also includes service discovery protocol 73 and discovered service information 76, which are used along with service related characteristics 75 to implement the service discovery and automatic self-configuration techniques as described above with respect to FIGS. 1, 2 and 3."

The applicant has described the invention using the discovery protocol 73 and discovered service information 76, which are used along with service related characteristics 75 to implement the service discovery and automatic self-configuration techniques". However, the disclosure did not provide any meaningful degree of specificity to implement "service discovery protocol and automatic configuration". The applicant failed to provide what the "service discovery protocol and automatic configuration" are and how they perform those functions in the disclosure. The applicant has disclosed many blocks to perform main functions of the invention. Those blocks are merely boxes with labels. One of ordinary skill in the art would not know how to make and use the invention or carrying out the invention .

Claims 1-43 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-43, as understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Sarker et al, U.S. Patent Number 7,272,643 (hereinafter Sarker).

Sarker discloses a system and a method for automatically configuring devices on a network (see col. 2, lines 8-35). Sarker discloses the invention substantially as claimed. Taking claim 1 as an exemplary claim, Sarker teaches a method comprising: automatically communicating service related characteristics associated with a first customer premise device (see Profile-Based Routing configuration, determining

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reachability); and receiving, at the first customer premise device in response to the service related characteristics, discovered service information associated with at least one other customer premise device (202) that shares the service related characteristics (see col. 7, col. 10, lines 50-55, method for performing Profile-Based Routing configuration; discovered routing profiles from the device configuration).

As per claim 2, Sarker discloses the method of claim 1, further comprising automatically configuring a service of the first customer premise device based on the service related characteristics and the discovered service information (see col. 7, col. 10, lines 50-55, method for performing Profile-Based Routing configuration; discovered routing profiles from the device configuration).

As per claim 3, Sarker discloses the method of claim 2, wherein the service comprises at least one of active performance measurement services, inventory management, device management services, Quality of Service (QoS), security services, and service level agreements (see col. 2, lines 36-60, col. Col. 5, lines 5-28).

As per claim 4, Sarker discloses the method of claim 1, wherein the service is a virtual private network (see col., 4, lines 41-45; VPN and VRs).

As per claim 5, Sarker discloses the method of claim 4, wherein the service related characteristics comprise at least one of a site identification, a virtual private

network identification, a topology of a virtual private network, customer premise device information, Internet Protocol address, quality of service information, device virtual private network status, and type of virtual private network (see col. 4, lines 41-64, Software Environment Section).

As per claim 6, Sarker discloses the method of claim 1, wherein the step of communicating service related characteristics comprises communicating the service related characteristics to a second device (see fig. 2, col. 4, lines 15-40).

As per claim 7, Sarker discloses the method of claim 6, wherein the second device is a public router (see fig. 2, routers).

As per claim 8, Sarker discloses the method of claim 6, wherein the second device is a second customer premise device (see fig. 2, col. 4, 202).

As per claim 9, Sarker discloses the method of claim 1, further comprising periodically communicating the service related characteristics to other devices (see col. 4, lines 41-64, Software Environment Section).

As per claim 10, Sarker discloses the method of claim 1, further comprising communicating the service related characteristics from the first customer premise

device to other devices upon a receiving a service configuration update (see Profile-Based Routing configuration, determining reachability).

As per claim 11, Sarker discloses the method of claim 1, further comprising querying other network devices to discover service information associated with at least one other customer premise device that shares the service related characteristics (see Profile-Based Routing configuration, determining reachability).

As per claim 12, Sarker discloses the method of claim 11, further comprising communicating service information associated with the first customer premise device to the at least one other customer premise device (see Profile-Based Routing configuration, determining reachability).

As per claim 13, Sarker discloses the method of claim 12, further comprising updating a service configuration of the at least one other customer premise device based on the service information associated with the first customer premise device (see Profile-Based Routing configuration, determining reachability).

As per claims 14-43, they do not teach or further define over the limitations recited in claims 1-13. Therefore, claims 14-43 are also rejected for same reasons set forth in claims 1-13, supra.

Claims 1, 14, 18, 23, 30 and 37, as understood, are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Lo, U.S. Patent Number 7,111,054 (hereinafter Lo).

As per claims 1, 14, 18, 23, 30 and 37, Lo discloses a system and method for automatically configuring customer premises equipment (see abstract). Taking claim 1 as an exemplary claim, Lo discloses a method comprising: automatically communicating service related characteristics associated with a first customer premise device (see column 1, line 60 to column 2, line 35; column 3, lines 1-5; element 160); and receiving, at the first customer premise device in response to the service related characteristics, discovered service information associated with at least one other customer premise device that shares the service related characteristics (see col. 3, line 20 to col. 4, line 39, discovered configuration values stored in configuration register 222).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (please see attached PTOL 892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zarni Maung whose telephone number is (571) 272-3939. The Examiner can normally be reached on Monday-Friday from 8:30 to 5:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, John Follansbee can be reached at (571) 272-3964. Any inquiry of a general nature or relating to the status of this application or proceeding should be

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directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free).

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ZARNI MAUNG
PRIMARY EXAMINER